

### REMARKS

This Amendment is submitted simultaneously with filing of a Request for Continuing Examination.

In the present Amendment applicants amended Claim 1 by incorporating into it the features of Claim 26, and also added Claims 27-30.

It is respectfully submitted that the new features of the present invention as defined in amended Claim 1 are not disclosed in the prior art applied by the Examiner in the final Office Action and cannot be derived from it as a matter of obviousness.

Claim 1 as amended specifically defines that at least one of the clamping faces (22) has a knurling (46) extending in the radial direction, and the radial knurling (46) is configured so that under the action of an axial clamping force it digs into the contact faces (20) of the magnet (3) or into the surface coating of the same.

Turning now to the references and in particular to the Wehrle reference, this reference does not disclose any radial knurling as admitted by the Examiner in the Office Action. The Examiner further stated that the Oberle et al

reference taught a knurling extending in the radial direction. However, it is respectfully submitted that there is no radial knurling in the Oberle reference. In the embodiment of Figures 2 and 4 there is no knurling, but instead there is a microscopic structure in which the teeth of the component (24) engage into corresponding slots of the magnet.

In the rotor in accordance with the present invention the knurling digs into contact faces or surface coating of the magnet under the action of an axial clamping force. This means that the magnet itself has not axial recesses or radial knurling, but instead has a contact face.

The construction of the rotor defined now in Claim 1 has significant advantage, in that during the manufacture no tolerances must be taken into consideration for the form-locking connection between the magnet and the contact faces, as in the Oberle reference. The rotor in accordance with the present invention provides for a significant simplification of the manufacture and mounting of the electric motor when compared with the patent to Oberle. Since the knurling digs itself into the smooth contact faces of the magnet, the depressions which are thusly produced in the contact faces of the magnet always fully correspond to the knurling.

It should be further mentioned that the device disclosed in the patent to Oberle, in which there is no spring elements, can be considered as combinable with the device disclosed in the Wehrle reference as a matter of obviousness. The alleged obviousness of the combination results only from the Examiner's familiarization with the present invention.

The advantage of the spring axial clamping force is that, independently from the concrete construction of the axial form-lock, by digging of the knurling the maximum clamping force cannot be exceeded. Thereby the damage to the ring magnet is prevented.

It is believed to be clear that the combination of the Wehrle and Oberle reference, as well as additionally with the Oshima reference, would not lead to the applicant's invention. Instead, the references have to be fundamentally modified by including into them the new features of the present invention which are defined in Claim 1 and were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Also, as explained hereinabove, the present invention provides for the highly advantages results which can not be accomplished by the constructions disclosed in the references. It is well known that in order to support a valid rejection in the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushma and Takahashi* (174 UPSQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of the original skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments it is believed that Claim 1 as amended should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims define additional features, and they should be considered as patentable because they contain the new features of Claim 1.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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